

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Group Art Unit: 3637
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Robert Mills et al.) Examiner: Ayres, Timothy
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Serial No.: 10/712,286)
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Filed: November 12, 2003)
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For: BOOK RACK AND PENCIL TRAY)
COMBINATION)

RESPONSE TO OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action mailed
March 21, 2006.

AMENDMENTS TO THE CLAIMS

1-8. (Canceled)

9. (Currently Amended) A book rack and pencil tray combination comprising:

(a) a wire mesh book rack having a bottom wall and a front opening;

(b) a pencil case having a first section with a bottom wall, a pair of opposed side walls, a front wall and a rear wall, and a portion being sized to retain one or more of a ruler or a protractor in a linear manner within the walls of the first section pencil case, and a second section portion of the pencil case with a bottom wall, a pair of opposed side walls, a front wall and a rear wall, the bottom wall of the second section being disposed in a generally horizontal plane at an elevation lower than the bottom wall of the first section book rack; and

(c) a pencil case attachment plate attached to the bottom wall of the pencil case such that a portion of the bottom wall of the book rack is sandwiched between the pencil case attachment plate and the bottom wall of the pencil case.

10. (Original) The combination of claim 9 wherein the pencil case defines a pair of separate compartments, a lower compartment and an upper compartment, and wherein the lower compartment is disposed outside the front opening of the book rack.

11. (Original) The combination of claim 10 wherein the bottom wall of the book rack is disposed in a generally horizontal first plane and the lower compartment of the pencil

case is disposed in a second generally horizontal plane, the second plane being disposed at an elevation below the first plane.

12. (Currently Amended) A desk comprising:

(a) a desk top having a top surface and a bottom surface;

(b) a support structure for supporting the desk top at an elevation above floor level;

(c) a wire mesh book rack having a bottom wall and a front opening;

(d) a pencil case having a first section with a bottom wall, a pair of opposed side walls, a front wall and a rear wall, and a portion being sized to retain one or more of a ruler or a protractor in a linear manner within the walls of the first section pencil case, and a second section portion of the pencil case with a bottom wall, a pair of opposed side walls, a front wall and a rear wall, the bottom wall of the second section being disposed in a generally horizontal plane at an elevation lower than the bottom wall of the first section book rack; and

(e) a pencil case attachment plate attached to the bottom wall of the pencil case such that a portion of the bottom wall of the book rack is sandwiched between the pencil case attachment plate and the bottom wall of the pencil case.

13. (Original) The combination of claim 12 wherein the pencil case defines a pair of separate compartments, a lower compartment and an upper compartment, and wherein the lower compartment is disposed outside the front opening of the book rack.

14. (Original) The combination of claim 13 wherein the bottom wall of the book rack is disposed in a generally horizontal first plane and the lower compartment of the pencil case is disposed in a second generally horizontal plane, the second plane being disposed at an elevation below the first plane.

15. (New) A book rack and pencil tray combination comprising:

(a) a wire mesh book rack having a front opening and a bottom wall, the bottom wall having an upper side and a lower side; and

(b) a pencil case attached adjacent to the lower side of the bottom wall of the book rack, the pencil case having a first section with a bottom wall, a pair of opposed side walls, a front wall and a rear wall, and a second section with a bottom wall, a pair of opposed side walls, a front wall and a rear wall, the bottom wall of the second section being disposed in a generally horizontal plane at an elevation lower than the bottom wall of the first section.

16. (New) A desk comprising:

(a) a desk top having a top surface and a bottom surface;

(b) a support structure for supporting the desk top at an elevation above floor level;

(c) a wire mesh book rack having a front opening and a bottom wall, the bottom wall having an upper side and a lower side; and

(d) a pencil case attached adjacent to the lower side of the bottom wall of the book rack, the pencil case having

a first section with a bottom wall, a pair of opposed side walls, a front wall and a rear wall, and a second section with a bottom wall, a pair of opposed side walls, a front wall and a rear wall, the bottom wall of the second section being disposed in a generally horizontal plane at an elevation lower than the bottom wall of the first section.

REMARKS

Claims 1-14 are presently pending in this application.

Rejections Under 35 U.S.C. § 112

Claims 1, 5, 9 and 12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In the examiner's opinion, the phrase "a linear manner within the walls" in claims 1, 5, 9 and 12 is indefinite. By the amendments herein, claims 1 and 5 have been canceled and the phrase "a linear manner" has been deleted in claims 9 and 12. Accordingly, applicants respectfully request that the rejection of claims 9 and 12 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1, 3-5, 7 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Huang (U.S. Pat. No. 5,623,881). Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Phillips (U.S. Pat. Publication 2003/0177959). Claims 1, 3-5, 7 and 8 have been canceled. Accordingly, the rejection of these claims is now moot.

Rejections Under 35 U.S.C. § 103

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barecki et al. (U.S. Pat. No. 3,758,182) in view of Lundahl (U.S. Pat. No. 2,535,743) and Rapp-Duncan (U.S. Pat. No. 6,056,178). Claims 1-8 have been canceled.

Applicants respectfully traverse these rejections as applied to claims 9-14.

The invention as presently claimed solves the long-standing problem of how to provide a pencil tray to student desks having a wire mesh book rack. The case for obviousness put forward by the examiner against claims 9-14 fails to make a *prima facie* case for obviousness. Moreover, even if the examiner provided a *prima facie* case of evidence, the invention was not made obvious by the combination of references cited in support of the rejections under 35 U.S.C. § 103.

The examiner's position fails to make a *prima facie* case for obviousness because each of claims 9-14 require a "pencil case attachment plate attached to the bottom wall of the pencil case such that a portion of the bottom wall of the book rack is sandwiched between the pencil case attachment plate and the bottom wall of the pencil case." Nowhere in the references is there disclosed or fairly suggested any such "pencil case attachment plate attached to the bottom wall of the pencil case that a portion of the bottom wall of the book rack is sandwiched between the pencil case attachment plate and the bottom wall of the pencil case." Accordingly, for this first reason, the rejection of claims 9-14 under 35 U.S.C. § 103 is in error and should be withdrawn.

Secondly, each of claims 9-14 have now been amended to require that the section of the pencil case disposed at an elevation lower than the bottom wall of the rest of the book rack have "a bottom wall, a pair of opposed side walls, a front wall and a rear wall." Nothing in the references currently cited in

support of the rejections under 35 U.S.C. § 103 discloses or fairly suggests a pencil case having such a configuration. Thus, for this additional reason, the cited references do not make out a *prima facie* case of obviousness. Accordingly, for this second reason, the rejections of claims 9-14 under 35 U.S.C. § 103 is inappropriate and should be withdrawn.

Finally, even if the cited references provided a *prima facie* case of obviousness against claims 9-14, the rejection of claims 9-14 under 35 U.S.C. § 103 would be in error. There is nothing in these three references -- or in any of the other references cited in this application -- that would make obvious the piecemeal combination of various components of the devices disclosed in the three cited references in such a way as to achieve the invention. Barecki et al. merely recites the prior use of student desks having a wire mesh book rack. Barecki et al. teaches away from the invention by teaching the use of a pencil tray in the cited desk only as a replacement for the wire mesh book rack. Thus, Barecki et al. emphasizes the prior belief among those of ordinary skill in the art that the use of a pencil case in combination with a wire mesh book rack was not possible, or least not practical.

The Lundahl reference discloses a pencil case, but not one which could possibly be attached to a wire mesh book rack. There is nothing in Barecki et al. or Lundahl which would suggest or give incentive to those of ordinary skill in the art to combine the teachings of Lundahl and Barecki et al. for any reason.

The Rapp-Duncan reference teaches the attachment of a wire mesh bin to the side of a wire mesh shopping cart. Rapp-Duncan is neither addressed to student desks or to pencil trays. The auxiliary bin taught by Rapp-Duncan has utility in the Rapp-Duncan shopping cart combination because both the side of the shopping cart and the auxiliary bin are disposed upright. If, however, the auxiliary bin is somehow attached to the wire mesh book rack disclosed in Barecki et al., anything placed in the auxiliary bin would either fall through the holes in the wire mesh or gravitate out of the opening. Accordingly, there is nothing in Rapp-Duncan or in Barecki et al. which would suggest or give incentive to those of ordinary skill in the art attaching the auxiliary bin of Rapp-Duncan to the wire mesh book rack of Barecki et al.

Finally, there is nothing in the three references, Barecki et al., Lundahl and Rapp-Duncan, which would suggest to those of ordinary skill in the art by a three-way combination of these references or otherwise give incentive to those of ordinary skill in the art to somehow construct a pencil case as claimed in the application and attach it to the wire mesh book rack disclosed in Barecki et al. Any attempted reconstruction of the invention based on a three-way combination of Barecki et al., Lundahl and Rapp-Duncan would require impermissible hindsight and piecemeal reconstruction. Accordingly, for this third reason, the rejection of claims 9-14 under 35 U.S.C. § 103 is in error and should be withdrawn.

New Claims 15 and 16

New claims 15 and 16 are substantially identical to claims 9 and 12, except that the requirements that the pencil case be sized to retain one or more of a ruler or a protractor and that the pencil case be attached by a pencil case attachment plate have been removed. Applicants, however, submit that these two new claims are patentable over the prior art. Specifically, a rejection under 35 U.S.C. § 103(a) based upon a combination of Barecki et al., Lundahl and Rapp-Duncan would be erroneous for the first and third reasons cited above with respect to the rejection of claims 9-14 under 35 U.S.C. § 103.

CONCLUSION

For the reasons set forth above, applicant respectfully submits that all of the claims remaining in the application are now in condition for allowance. Accordingly, reconsideration, reexamination and allowance of all claims is requested.

Respectfully submitted,

SHELDON & MAK

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